



2133

Docket: ARC9-2000-0071-US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTORS: Blaum, et al.

SERIAL NO.: 09/849,397 **GROUP ART UNIT:** 2133

FILED: 05/07/2001 **EXAMINER:** R. Stephen Dildine

FOR: METHOD AND SYSTEM FOR SYNCHRONIZATION IN THE
PRESENCE OF THERMAL ASPERITY

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO WITHDRAW HOLDING OF ABANDONMENT

--OFFICE ACTION DELIVERED BY FAX BEFORE OFFICE ACTION DEADLINE--

A Notice of Abandonment for the above-identified application ("Application") was mailed on 18 January 2005. This notice states that "This application is abandoned in view of ... Applicant's failure to timely file a proper reply to the Office letter mailed on 23 April 2004 ... No reply has been received." The 23 April 2004 office action included a shortened statutory period for reply of 3-months (e.g., by 23 July 2004).

**APPLICANT HEREBY PETITIONS FOR WITHDRAWAL FROM
EXAMINER'S HOLDING OF ABANDONMENT**

1. Pursuant to 37 C.F.R. §1.8(b), I hereby petition to withdraw the holding of abandonment in this Application, on the basis that a reply to the 23 April 2004 Office Action was sent by facsimile to the Patent Office on 23 July 2004. Per 37 C.F.R. §§1.6(d) and 1.8(a)(1)(B), the receipt date for an office action reply sent by facsimile is the date on which the complete transmission was received by the Patent Office.
2. I hereby state that the office action reply was sent 23 July 2004 based on available documentation. I have attached the relevant pages, include true copies of the: (i) Auto-Reply Facsimile Transmission return receipt generated on 23 July 2004; and (ii) counsel's twenty-one page reply to the 23 April 2004 Office Action dated 23 July 2004. Pursuant to 37 C.F.R. §1.8(b)(3), the facsimile return receipt may be used by the Director to support my statements.
3. No fee is required for this petition per MPEP §711.03(c)(I).
4. The Application was filed after 8 June 1995, therefore no terminal disclaimer is required.

Respectfully submitted,

Patrick W. Duncan

Date: 4/28/05 By:



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O! P E
MAY 02 2005
P A T E N T & T R A D E M A R K S O F C I V I C S
In re application of: Blaum et al.
Serial No.: 09/849,397
Filed: May 7, 2001
For: METHOD AND SYSTEM FOR SYNCHRONIZATION IN THE
PRESENCE OF THERMAL ASPERITY

ASSISTANT COMMISSIONER OF PATENTS & TRADEMARKS
Alexandria, VA 22313-1450

SIR:

Transmitted herewith in the above-identified application are:

Petition to Withdrawal of Abandonment
 Information Disclosure Statement (37 CFR 1.97(c) with references
 Notice to File Missing Parts of Application -- Filing Date Granted
 No additional fee is required.

The fee has been calculated as shown below:				CLAIMS	HIGHEST NO.	
REMAINING AFTER AMENDMENT	PREVIOUSLY PAID FOR	PRESENT EXTRA			ADDIT.	RATE
FEE						
TOTAL	13	MINUS	20	=	0 x 50 =	\$ 0 \$ 0
INDEP.	5	MINUS	6	=	0 x 200	\$ 0 0
					Surcharge	\$ 0
					TOTAL	\$ 0

Please charge my Deposit Account No. _____ in the amount of \$
A duplicate copy of this sheet is attached.
 The Commissioner is hereby authorized to charge payment of the following
fees associated with this communication or credit any overpayment to Deposit
Account 50-2587. A duplicate copy of this sheet is attached.
 Any filing fees under 37 CFR 1.16 for the presentation of extra claims.
 Any patent application processing fees under 37 CFR 1.17

Patrick Duncan 4/26/05

Patrick Duncan, (Reg. No. 41,721)
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CERTIFICATE OF MAILING

I hereby certify that the above paper/fee is
being deposited with the United States Postal
Service via facsimile
addressed to the Assistant Commissioner of
Patents, Alexandria, VA 22313-1450 on
April 27, 2005.

Person Mailing paper/fee: Diane Cascia

Signature Diane Cascia



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/849,397 05/07/2001 Mario Blaum ARC920000071US1 9457

21254 7590 04/23/2004

MCGINN & GIBB, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

EXAMINER

DILDINE JR, R STEPHEN

ART UNIT

PAPER NUMBER

2133

DATE MAILED: 04/23/2004

RECEIVED

APR 26 2004

ACM. 048
McGINN & GIBB, P.C.

7/23/04

10/23/04

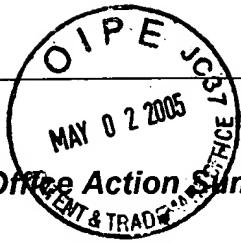
Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action w/allowable
Claims
Response Due 1/23/04

TELECTUAL PROPERTY LAW
IBM-ALMADEN

2004 MAY -5 P 12: 14



Office Action Summary

Application No.

09/849,397

Applicant(s)

BLAUM ET AL.

Examiner

R. Stephen Dildine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 March 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 26-29 is/are allowed.
- 6) Claim(s) 1,10-13,25 and 30 is/are rejected.
- 7) Claim(s) 2-9,14-24 and 31-37 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12 March 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____.
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Notice of References Cited

Application/Control No.
09/849,397

Applicant(s)/Patent Under
Reexamination
BLAUM ET AL.

Examiner
R. Stephen Dildine

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U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-6,711,225 B1	03-2004	Sutardja et al.	375/364
	B	US-6,693,760 B1	02-2004	Krounbi et al.	360/75
	C	US-6,690,524 B1	02-2004	Wakefield et al.	360/51
	D	US-6,690,523 B1	02-2004	Nguyen et al.	360/31
	E	US-6,680,807 B1	01-2004	She et al.	360/51
	F	US-5,347,517 A	09-1994	Satomura et al.	714/708
	G	US-4,931,884 A	06-1990	Aoki, Yoshitaka	360/26
	H	US-4,575,774 A	03-1986	Tarbox et al.	360/72.2
	I	US-4,499,507 A	02-1985	Yamada et al.	360/26
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N	JP H11-341066 A	12-1999	Japan	Lawren (sic) L. Post.	H04L 12/56
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.



Note: Reference "N" (Lawren (sic) L Post (JP H11-341066)) of the included form PTO-892 includes a computer generated English translation.

The drawings were received on March 12, 2004. Figures 1-6 of these drawings are acceptable. Figure 7 is objected to because said figure should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. Figure 7 only illustrates a prior art 3½ inch removable computer disc recording media; contrary to applicants' remarks at page 17 of the response, the steps of a program stored thereon are not illustrated in Figure 7, only the prior art medium per se. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claims 1, 10-13 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Goode et al. Applicant has based his traverse of this rejection upon the fact that Goode et al. disclose their invention in a time division multiplexing data communication system in contrast to applicants' disclosure of a magnetic recording environment; however, no limitation of a magnetic recording environment is recited in the rejected claims. MPEP 2106 states the following: "Limitations appearing in the specification but not recited in the claim are not read into the claim. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process."), and "Office personnel should also be especially careful not to read into a claim unclaimed results, limitations or embodiments of an invention. See Carl Zeiss Stiftung v. Renishaw PLC, 945 F.2d 1173, 20 USPQ2d 1094 (Fed. Cir. 1991); In re Krimmel, 292 F.2d 948, 130 USPQ 215 (CCPA 1961)."

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Claims 1, 10-11, 13 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Magnin. Applicant has based his traverse of this rejection upon the fact that Magnin disclose his invention in a PCM system in contrast to applicants' disclosure of a magnetic recording environment; however, no limitation of a magnetic recording environment is recited in the rejected claims. Applicant further bases his traverse upon a lack of a certain Hamming distance between the synchronization patterns of the reference; however, the rejected claims fail to recite any Hamming distance criteria. MPEP 2106 states the following: "Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.")", and "Office personnel should also be especially careful not to read into a claim unclaimed results, limitations or embodiments of an invention. See *Carl Zeiss Stiftung v. Renishaw PLC*, 945 F.2d 1173, 20 USPQ2d 1094 (Fed. Cir. 1991); *In re Krimmel*, 292 F.2d 948, 130 USPQ 215 (CCPA 1961)."

NEW GROUNDS OF REJECTION

Claim 30 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Goode et al. in view of Lawren (sic) L Post (JP H11-341066). The applied reference to Lawren (sic) L Post (JP H11-341066) was published on December 10, 1999 which qualifies the reference under 35 U.S.C. 102 (b) since applicants' application was filed more than one year later on May 7, 2001.

Claim 30 is claiming appending a synchronization symbol to random data by means of a signal-bearing medium tangibly embodying a program of machine-readable instructions executable by a digital processing apparatus (i.e. a computer program).

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Goode et al. discloses appending a synchronization symbol to random data ("synchronizing signals or codes be prefixed to or interposed between coded messages" Col. 1, lines 32-33) (Note: to append means attach or affix and includes to prefix and to interpose). Note that Goode et al. mentions at column 4, lines 48 – 50 "Of course, if there is a fixed code for a given application of the system, a fixed- wire program may be 50 utilized in place of switches SI-SN"

Goode et al. lacks or does not expressly disclose use of a computer program to perform said appending of a synchronization symbol to random data.

Post discloses a method "which find the synchronization point of a data stream." (Paragraph [0007]) and further teaches the "process of this invention is the form of the medium of the instruction which can be read by computer" (Paragraph [0031]).

At the time of Applicants' invention, one skilled in the art would have been lead to implement appending a synchronization symbol to random data by a program of computer instructions recorded on a medium as taught by Post because the fixed wire program suggested by the 1966 reference of Goode et al has, over the years, become antiquated and one skilled in the art would naturally seek out a modern way to automate the process.

Claims 2-9, 14-24 and 30-37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 26-29 are allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sutardja et al., Krounbi et al., Wakefield et al., Nguyen et al., She et al., Satomura et al., Aoki, Tarbox et al. and Yamada et al. all deal with synchronization in magnetic recording environments.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Stephen Dildine whose telephone number is 703-305-5524. The examiner can normally be reached on M, Tu, Th, F 5:55 am to 4:25 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decayd can be reached on 703-305-9595. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

R. Stephen Dildine
Primary Examiner
Art Unit 2133



R. Stephen Dildine